UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/469,561	12/22/1999	MARTIN PAGEL	045923-P016U	5104

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EXAMINER
WU, RUTAO

ART UNIT	PAPER NUMBER
3628	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/16/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

	Application No.	Applicant(s)
Office Action Summary	09/469,561	PAGEL, MARTIN
	Examiner	Art Unit	
	Rob Wu	3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>25 October 2006</u>.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-4, 6-19, 21-27, 30-34 and 37-40* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☒ Claim(s) *31 and 32* is/are allowed.

6) ☒ Claim(s) *1-4, 6-19, 21-27, 30, 33, 34 and 37-40* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Status of Claims

1.   Claims 1-4, 6-19, 21-27, 30-34, 37-40 are pending in the current application.

Response to Arguments

2.   Applicant's arguments with respect to claims 1-4, 6-19, 21-27, 30-34, 37-40 have

been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public
> use or on sale in this country, more than one year prior to the date of application for patent in the United
> States.

4.   Claims 1-4, 6-19, 21-27, 30, 33-34, 37-40 are rejected under 35 U.S.C. 102(b) as

being anticipated by U.S. Pat No. 5,684,706 to Harman et al.

Referring to claim 1:

A method of printing a data stream being presented to a printer, said data stream

adapted to enable said printer to print on one or more sheets of paper information in

accordance with said data stream, said data stream containing data bits useful for

controlling functions additional to said printing information in accordance with said data

stream, said method comprising:

Abstracting at least a portion of said data bits from said data stream with a postal printer driver; (col 5: lines 37-41)

Using at least some of said abstracted data bits for controlling at least one of said additional functions, wherein said at least one of said additional functions comprises printing of a postage indicia, and wherein said at least one additional function further comprises accepting data from a source other than said data stream; (col 6: lines 4-11)

Creating , from said abstracted data bits, a separate data stream for controlling the printing of said postage indicia. (col 6: lines 9-14)

Referring to claim 2:

The method of claim 1 wherein said at least one additional function comprises printing of address information on material separate from said printing information in accordance with said data stream. (col 6: lines 36-40)

Referring to claim 3:

The method of claim 1 wherein said at least one additional function further comprises the printing of a postage indicia on material separate from said printing information in accordance with said data stream. (col 6: lines 11-14)

Referring to claim 4:

The method of claim 1 wherein said at least one additional function further comprises a dialog box for allowing options from a user (col 4: lines 36-41)

Referring to claim 6:

The method of claim 1 wherein said at least one additional function further comprises directing the abstracted portion to multiple locations. (col 5: lines 36-41)

Referring to claim 7:

The method of claim 1 wherein said at least one additional function further

comprises storage in a memory. (col 5: lines 42-45)

Referring to claim 8:

The method of claim 1 wherein said at least one additional function further

comprises directing the abstracted portion to a viewable medium. (col 5: lines 40-41, Fig

4 [Document Engine])

Referring to claim 9:

The method of claim 1 wherein said at least one additional function further

comprises the changing of form of the data (col 6: lines 10-14)

Referring to claim 10:

The method of claim 1 wherein said at least one additional function further

comprises the delivery of said data to a location remote from said printer driver. (col 5:

lines 37-40)

Referring to claim 11:

The method pf claim 1, wherein said at least one additional function further

comprises the change in at least one of location and format of the data based upon an

interaction between certain data in said data stream and data stored in said printer

driver. (col 5: lines 37-40)

Referring to claim 12:

The method of claim 1 wherein said printer driver is operable on said data stream

coming from a program operating in a computing device to control at least a portion of

the printing of said printer. (col 4: lines 35-41)

Referring to claim 13:

The method of claim 12 wherein said printer driver is located remote from said

computing device. (Fig 1)

Referring to claim 14:

The method of claim 12 wherein said printer driver is located within said printer.

(col 5: lines 28-31)

Referring to claim 15:

The method of claim 12 wherein said abstracting includes:

Examining said data stream for preestablished data patterns. (col 5: lines 37-41,

Fig 2)

Referring to claim 16:

The method of claim 15 wherein said data patterns are selected from the list

including:

Return address, destination address, mailing date, number of pages, type of

inserts, mailing service type, postage indicia, bar codes, tracking codes, control codes,

graphics, application types. (col 3: lines 54-65, Fig 2)

Referring to claim 17:

A method of printing a data stream being presented to a printer, said data stream

adapted to enable said printer to print on one or more sheets of paper information in

accordance with said data stream, said data stream containing data bits useful for

controlling functions additional to said printing information in accordance with said data

stream, said method comprising:

Abstracting at least a portion of said data bits from said data stream; (col 5: lines

37-41)

Using at least some of said abstracted data bits for controlling at least one of said

additional functions, wherein said at least one of said additional functions comprises

printing of a postage indicia, (col 6: lines 4-11) and

Creating , from said abstracted data bits, a separate data stream for controlling

the printing of said postage indicia. (col 6: lines 9-14)

Wherein said printer driver is operable on said data stream coming from a

program operating in a computing device to control at least a portion of the printing of

said printer, wherein said abstracting includes examining said data stream for

preestablished data patterns, and wherein said preestablished data patterns include the

beginning and ending of postage indicia data. (col 4: lines 32-41; col 5: lines 21-24, 37-

41, Fig 2)

Referring to claim 18:

The method of claim 15 wherein said additional function further comprises the

printing of said postage indicia on a document other than the document to which said

data stream is being directed. (col 6: lines 9-11)

Referring to claim 19:

The method of claim 15 wherein said preestablished data patterns include the beginning and ending of address information contained within said data stream. (col 4: lines 25-26, Fig 2)

Referring to claim 21:

The method of claim 15 wherein said preestablished data patterns include the beginning and ending of each document to be printed. (col 4: lines 18-20, Fig 2)

Referring to claim 22:

The method of claim 15 wherein said preestablished data patterns include the number of pages of a document. (col 3: lines 57-60, Fig 2)

Referring to claim 23:

A method of printing information on a printed document, said method comprising the steps of:

Sending a data stream to a printing device; (col 5: line 37)

Reviewing said data stream to create therefrom a separate data stream for controlling additional functions with respect to printing of documents, wherein said separate data stream includes data accepted from a source other than said data stream to said printing device. (col 5: lines 37-41; col 6: lines 4-11)

Mainintaing in a secure memory an amount available for controlling the generation of a postage indicia; (col 10: lines 10-15)

Calculating under joint control of said secure memory and said separate data stream an amount of postage to be applied to a particular document to be printed (col 6: lines 1-7)

Deducting said calculated postage amount from said secure memory if said

calculated postage amount is available in said secure memory (Fig 6B)

Printing information from said data stream in accordance with said additional

functions. (col 5: lines 37-45)

Referring to claim 24:

The method of claim 23 wherein said additional functions are selected from the

list including printing address information, printing postage indicia, folding a printed

document, stuffing a printed document into an envelope, creating a mailing address for

the delivery of a printed document, creating a postage indicia, creating an auxiliary

document in association with a printed document, controlling a second printer operating

in conjunction with said printer, verifying the address, normalizing the address, adding

delivery bar codes. (col 3: lines 57-65)

Referring to claim 25:

The method of claim 23 wherein said reviewing step includes the step of:

Copying from said data stream portions of said data stream. (col 5: lines 42-45)

Referring to claim 26:

The method of claim 25 wherein said portions include address information with

respected to a particular document to be printed. (col 5: lines 42-45)

Referring to claim 27:

The method of claim 26 further including the step of:

Creating from said copied address information a postage indicia. (col 6: lines 9-

15)

Referring to claim 30:

The method of claim 25 wherein said portions include postage indicia information

with respect to a particular document to be printed. (col 5: lines 42-45)

Referring to claim 33:

A computer program product, embodied on a computer-readable medium, for

use in association with a data stream being directed to a general purpose printer when

executed, said data stream adapted to enable said printer to print information in

accordance with said data stream, said computer program product comprising:

An abstracting program operable for reviewing said data stream to obtain

therefrom a separate data stream for controlling additional printing operation ancillary to

said printing operation, wherein said one ancillary operation further comprises the

acceptance of data from a source other than said data stream; (col 5: lines 37-41; col 6:

lines 4-11)

A controller working in cooperation with said abstracting program and with said

separate data stream for enabling at least one said ancillary printing operation, wherein

said at least one ancillary operation comprises the printing of a postage indicia on

material separate from material on which printing of said information is occurring. (col 6:

lines 4-11)

Referring to claim 34:

The computer product of claim 33 wherein said at least one ancillary operating

comprises the printing of address information on material separate from material on

which printing is occurring. (col 6: lines 35-37)

Referring to claim 37:

The computer product of claim 33 wherein said computer product is operable on

said data stream coming from a general purpose computing device. (col 4: lines 35-41)

Referring to claim 38:

The computer product of claim 37 wherein said computer product is located

remote from said computing device. (Fig 1)

Referring to claim 39:

The computer product of claim 37 wherein said computer product is located

within said printer. (col 5: lines 28-31)

Referring to claim 40:

The computer product of claim 33 wherein said abstracting program includes:

A control program for examining said data stream for certain preestablished data

patterns. (col 5: lines 37-41, Fig 2)

Allowable Subject Matter

5.   Claims 31 and 32 are objected to as being dependent upon a rejected base

claim, but would be allowable if rewritten in independent form including all of the

limitations of the base claim and any intervening claims.

Conclusion

6.   Examiner's Note: Examiner has cited particular columns and line numbers in the

references as applied to the claims below for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are

applied to the specific limitations within the individual claim, other passages and figures

may apply as well. It is respectfully requested that the applicant, in preparing the

responses, fully consider the references in entirety as potentially teaching all or part of

the claimed invention, as well as the context of the passage as taught by the prior art or
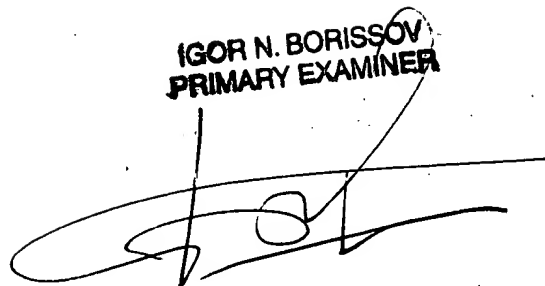
disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Rob Wu whose telephone number is (571)272-3136.

The examiner can normally be reached on Mon-Fri 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, John Hayes can be reached on (571)272-6708. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

rw

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PRIMARY EXAMINER